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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,573	07/24/2003	Michael Gerhard Hoffmann	09879-00034-US AGR2002/M2	5228
23416	7590	12/15/2004	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			RAO, DEEPAK R	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/627,573

Applicant(s)

HOFFMANN ET AL.

Examiner

Deepak Rao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 072403 & 051704.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

Claims 1-11 and 13-14 are pending in this application.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 3-11 and 13-14 are rejected under 35 U.S.C. 102(a) as being anticipated by Parra Rapado et al., WO 03/16308. The instant claims read on reference disclosed compounds, see formula I in page 1 and the corresponding compounds in Table 1, e.g., compound **Ia.3** (wherein W and Z are CH; Y is N); compound **Ia.9**, etc.

**Note:** Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-11 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofman et al., WO 03/022843. The reference teaches pyrazolyl-substituted thienyloxy pyridine compounds that are structurally analogous to instantly claimed compounds. See the structural formula I in page 1 and the corresponding species in Tables 1 and 3. The compounds are taught to be useful as agrochemical agents useful in combating undesired plants, see the abstract. The instant compounds differ from the reference compounds by having the  $-CF_3$  group on the pyrazolyl ring at a position different from the reference compounds, i.e., at the 3-position as compared to 4-position in the instant claims and therefore, the instantly claimed compounds are positional isomers of the reference compounds. It would have been obvious to one having ordinary skill in the art at the time of the invention to prepare the instantly claimed compounds because they are positional isomers of the reference compounds. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such isomeric compounds are suggestive of one another and would be expected to share similar properties and therefore, the same use as taught for the reference compounds, i.e., as agrochemical agents. It has been held that a compound, which is structurally isomeric with a

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compound of prior art is prima facie obvious absent unexpected results. *In re Finley*, 81 USPQ 383 (CCPA 1949); *In re Norris*, 84 USPQ 458 (CCPA 1950); *In re Dillon*, 919 F.2d at 696, 16 USPQ2d at 1904 (Fed. Cir. 1990).

**Note:** Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

2. Claims 1-11 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maier et al., EP 1,101,764. The reference teaches 2-aryloxy-pyrazol-1-yl-pyridine compounds that are structurally analogous to instantly claimed compounds. See the structural formula I in page 2 and the corresponding species in Table 1. The compounds are taught to be useful as herbicidal agents, see the abstract. The instant compounds differ from the reference compounds by having the  $-CF_3$  group on the pyrazolyl ring at a position different from the reference compounds, i.e., at the 3-position as compared to 4-position in the instant claims and therefore, the instantly claimed compounds are positional isomers of the reference compounds. It would have been obvious to one having ordinary skill in the art at the time of the invention to prepare the instantly claimed compounds because they are positional isomers of the reference compounds. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such isomeric compounds are suggestive of one another and would be expected to share similar properties and therefore, the same use as taught for the reference compounds, i.e., as herbicidal agents. It has been held that a compound, which is structurally isomeric with a compound of prior art is prima facie obvious absent unexpected

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results. *In re Finley*, 81 USPQ 383 (CCPA 1949); *In re Norris*, 84 USPQ 458 (CCPA 1950); *In re Dillon*, 919 F.2d at 696, 16 USPQ2d at 1904 (Fed. Cir. 1990).

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-11 and 13-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 and 14-15 of copending Application No. 10/627,256. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed compounds are structural analogs of the reference compounds. See claim 1 in the copending application drawn to structural formula I wherein Y is 2-pyridine as compared to the instant claims wherein the analogous substituent A is a 3-pyridine. The compounds of the reference are useful as herbicides. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such structurally homologous compounds would be expected to possess similar utilities.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. Claims 1-11 and 13-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 10-12 of copending Application No. 10/487,549. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly claimed compounds are structural analogs of the reference compounds. See claim 1 in the copending application drawn to structural formula I wherein the  $-CF_3$  is attached to the pyrazol-1-yl group at the 3-position as compared to the instant claims wherein the substituent is attached at the 4-position. The compounds of the reference are useful as herbicides. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compounds because such structurally homologous compounds would be expected to possess similar utilities.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1, 3-11 and 13-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 9-11 of copending Application No. 10/486,398. Although the conflicting claims are not identical, they are not patentably distinct from each other because they substantially overlap the generic compounds of the reference. The reference teaches a generic group of compounds that embraces the applicant's instantly claimed compounds, see formula I disclosed in claim 1. The reference compounds are taught to be useful herbicidal agents, see claims 9-11. It would have been obvious to one having ordinary skill in the art at the time of the invention to select any of the

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species of the genus taught by the reference, including those instantly claimed, because the skilled chemist would have had the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as taught for the genus as a whole i.e., as herbicidal agents. One of ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Receipt is acknowledged of the Information Disclosure Statements filed on July 24, 2003 and May 17, 2004 and copies are enclosed herewith.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (571) 262-0674. If you are unable to reach Dr. Shah within a 24 hour period, please contact James O. Wilson, Acting-SPE of 1624 at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Deepak Rao', with a stylized flourish at the end.

**Deepak Rao**  
**Primary Examiner**  
**Art Unit 1624**

December 13, 2004